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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,120

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Carine Boursier

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EXAMINER

OBAYANJU, OMONIYI

ART UNIT

PAPER NUMBER

2617

NOTIFICATION DATE

DELIVERY MODE

03/29/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/583,120	Applicant(s) BOURSIER ET AL.	
	Examiner OMONIYI A. OBAYANJU	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-7 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-7 and 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>06/16/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 2-20 have been considered but are moot in view of the new ground(s) of rejection.

However, the Examiner further reviewed Applicant's arguments which have been found not persuasive.

In regards to the newly added independent claims, Applicant argued that the prior art references (Simmons and Portalier) fails to disclose or suggest at least in part "establish[ing] ... an encrypted communication channel between the first data storage device and the second data storage device,"

In response, the examiner respectfully disagrees with Applicant's argument. Even though Simmons did not specifically use the exact phrase "an encrypted communication channel" between storage device, it is well known and understood by one of ordinary skill in the art that the function of "an encrypted communication channel" is to provide means securely exchange information and preventing unauthorized communication. Therefore, being consistent with Applicant's specification, Simmons **in pp0042, and pp0049** inherently teaches establish[ing], based on [an] authentication (performing challenge process, and establishing it's suitability, and that the only the

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equipment with which the SIM will operate), an encrypted communication channel (challenge verification which makes tracing or reverse engineering difficult),"

In conclusion, to further clarify the rejection, the secondary reference (Portalier) **in pg. 3, lines 21-26** clearly teaches "establish[ing] ... an encrypted communication channel (coupling by means of an encryption algorithm) between the first data storage device and the second data storage device," Thus, given the claimed limitations its' broadest reasonable interpretation, the claim does not uniquely and particularly define the term **"an encrypted communication channel"** so as to distinguish from the applied prior art. During patent examination, the claims must be given their broadest reasonable interpretation. See also MPEP §2111. Broadly interpreted, **"an encrypted communication channel"** is fairly characterized as coupling by means of an encryption algorithm (pg. 3, lines 21-26).

Response to Amendment

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 4-7, 9, 11-20, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject

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matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is unclear the intentions and/or the reasons why the Applicant changed or amended the claimed limitations to recite "a first data storage device" and "a second data storage device". The newly amended and added terms were never mentioned and/or inconsistent with Applicant's specification. Therefore, the introduction of new terms that are not supported and/or described by the specification raises the issue of new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-7, 9, 11-16, and, 18-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons (US Publication No. 20040043792) in view of Portalier et al (UK Patent Application GB2355892).

As to claims 18, 19, 20, 5, and 12, Simmons teaches a telephone handset, comprising (fig. 1, #10): a first data storage device storing an International Mobile Equipment Identity (IMEI) associated with an operator of a communication network (pg.

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2, pp 0026, lines 1-4); a second data storage device (SIM, pg. 1, pp0006); a processor (fig. 1, Microcontroller); a memory device including program instructions that, when executed by the processor, control the handset to: authenticate, by the second data storage device, the first data storage device (pg. 3, pp 0030); establish, based on said authentication, a communication channel between the first data storage device and the second data storage device (pg.3, pp0042, pp0049); transmit, via a communication channel, the IMEI from the first data storage device to the second data storage device (pg. 4, pp 0049 lines 9-12); and enable the handset to access the communication network based on the IMEI received by the second data storage device (pg. 3, pp0028, and fig.1). However, Simmons fails to explicitly teach an encrypted communication channel between the first data storage device and the second data storage device.

But, Portalier teaches an encrypted communication channel between the first data storage device and the second data storage device (pg. 3, lines 21-26). Thus, it would have been obvious to one of ordinary skill in the art at time the invention was made to modify the terminal equipment teachings of Simmons with the teachings of Portalier to achieve an efficient, reliable, and secure communication link between devices in communication system.

As to **claims 2 and 9**, Simmons teaches wherein the operating system (fig. 1, Microcontroller) controls the transmission of the IMEI to a mobile telephone operator by means of a secure OTA channel (pg. 3, pp 0038, lines 4-8).

As to **claim 4**, Simmons teaches wherein the second data storage device is a UICC (SIM card) (pg. 3, pp 0028).

As to **claim 6**, Simmons teaches wherein the second data storage device and the first data storage device store encryption keys that are used to encrypt the secure communication channel (pg. 3, pp 0041, lines 1-10, and pp0042).

As to **claims 7, 11, and 13-16**, Simmons teaches wherein the second data storage device blocks the use of the handset when a false IMEI is detected (pg. 3, pp 0038 lines 4-7, and pp 0040).

Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons (US Publication No. 20040043792) in view of Portalier et al (UK Patent Application GB2355892) as applied to claim 9 above, and further in view of Applicant's Admitted Prior Art (AAPA).

As to **claims 10 and 17**, Simmons and Portalier teaches the limitations of claim 9 as discussed above. However, they fail to teach the operator comparing the IMEI with a black list of stolen handsets. Applicants Admitted Prior Art (AAPA) as set forth in Paragraph [0003] of the specification background teaches these limitations of claims 10 and 17 (blocking) . Thus, it would have been obvious to one of ordinary skill in the art at time the invention was made to include the teachings the Applicants Admitted Prior Art in the securing method of Simmons and Portalier in order to achieve the goal of efficiently securing a mobile terminal from an unauthorized use.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMONIYI A. OBAYANJU whose telephone number is (571)270-5885. The examiner can normally be reached on Mon - Fri, 7:30 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent P. Harper can be reached on 571-272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/O. A. O./
Examiner, Art Unit 2617

/VINCENT P. HARPER/
Supervisory Patent Examiner, Art
Unit 2617